

REMARKS

I. Introduction

Claims 15-23 and 26 are currently pending and stand rejected in the present application after cancellation of claim 23 in the present Amendment.

Applicants note with appreciation the Examiner's acceptance of drawings and consideration of the Information Disclosure Statement which were previously submitted.

II. Rejection of Claims 15, 16 and 26 under 35 U.S.C. § 102(b)

Claims 15, 16 and 26 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,060,776 ("Spitz"). Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In order to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See Scripps Clinic & Research Foundation v. Genentech, Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See Akzo, N.V. v. U.S.I.T.C., 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)). To the extent that the Examiner may be relying on the doctrine of inherent disclosure, the Examiner must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherence of that result or characteristic.

In support of the rejection, the Examiner contends that the claimed feature of the clearance recited in claim 15 is taught by trench 10 in Spitz. However, the Examiner's contention is clearly incorrect because a clearance, by definition, is an open space between two objects, but trench 10 of Spitz is filled with chip package material. Furthermore, the

trench 10 of Spitz is provided between the sleeve and a shoulder (reference item 15) of the base of the diode, i.e., the trench 10 of Spitz is located inside the sleeve and is filled with chip package material (reference item 13). (See Spitz, Fig. 1). In the present application, the trench is shown as item 9 in Figure 2, which trench is separate and distinct from “clearance A” which is (i) located on the outside of the sleeve, and (ii) between the exterior of the sleeve and the outer region of the upper area of the base. In order to highlight these points, Applicants have amended claim 15 to explicitly recite that “a clearance space is provided outside the sleeve between the exterior of the sleeve and an outer region of an upper area of the base, the clearance preventing contact between the exterior of the sleeve and the outer region of the upper area of the base.” The amended features of claim 15 are not suggested by Spitz.

For the foregoing reasons, claim 15 and its dependent claims 16 and 26 are allowable over Spitz.

III. Rejection of Claims 17-24 under 35 U.S.C. § 103(a)

Claims 17-24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Spitz. Applicants have canceled claim 24. Applicants respectfully submit that the rejection of pending claims 17-23 should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests all of the claim limitations. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 82 U.S.P.Q.2d 1385 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning

with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396.

Pending claims 17-23 ultimately depend on amended claim 15. As noted above, Spitz does not suggest the features of amended claim 15. For at least this reason, dependent claims 17-23 are similarly not suggested by, and allowable over, Spitz.

IV. CONCLUSION

In view of all of the above, it is respectfully submitted that all of the presently pending claims under consideration are in allowable condition. Prompt reconsideration and allowance of the application are respectfully requested.

Respectfully submitted,

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